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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,903	09/07/2001	Paul Mallo	S-4731	5310

466 7590 04/27/2004
YOUNG & THOMPSON
745 SOUTH 23RD STREET 2ND FLOOR
ARLINGTON, VA 22202

EXAMINER

YOON, TAE H

ART UNIT PAPER NUMBER

1714

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/856,903

Applicant(s)

MALLO ET AL.

Examiner

Tae H Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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The recited "more particularly", "such as" and "preferably" in claims 1, 3 and 5-8 are objected and separate dependent claims having such narrower limitations are suggested.

Also, corrections in following locations are needed; Page 4, line 11, "acid. or acid.", line 26 "[lacuna]" and page 7, line 27, "[lacuna]".

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The recited "use of" is non-statutory subject matter, and "A method of using the" is suggested.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "type" in (W/O) and (O/W) type" is indefinite and cancellation is suggested. The recited "[lacuna]" and "either of acrylamide" in claim 5 is confusing and indefinite. Improper Markush language is recited in claim 7, and a proper format is "is chosen (or selected) from the group consisting of A, B, C, --- and Z".

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al (US 5,185,395).

Robinson et al teach an emulsion polymerization and the inversed latex thereof in examples I and II wherein the use of sorbitan monooleate and 2-acrylamido-2-methylpropane sulfonic acid monomer are seen. Also, Robinson et al teach the addition of an O/W emulsifier (breaker system) at col. 4, lines 33-40. The amount of said acid monomer and oil phase are taught at col. 1, lines 52-55 and col. 2, lines 53-54.

The instant invention further recites an addition of an O/W emulsifier at temperature less than 50°C and a polymerization at pH of less than 5.5 over Robinson et al. However, Robinson et al teach that the polymerization is run at pH of 2-12 at col. 3, lines 39-41, and thus choosing a pH of less than 5.5 would be a *prima facie* obviousness.

It would have been obvious to one skilled in the art at the time of invention to polymerize the composition of examples I and II at pH of less than 5.5 since Robinson et al teach that the polymerization is run at pH of 2-12 and thus choosing a pH of less than 5.5 would be a *prima facie* obviousness, and to add an O/W emulsifier at temperature less than 50°C since Robinson et al teach an addition an O/W emulsifier after polymerization absent showing otherwise.

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Claims 1, 4 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al (US 5,185,395) in view of Griat (US 5,531,993) or Clark (US 5,290,479).

The instant invention further recites white mineral oil and cosmetic, dermatopharmaceutical and pharmaceutical compositions over Robinson et al. However, the use of said white mineral oil in the inverse latex is well known as taught by Clark, col. 17, lines 67-68, and the use of the inverse latex in cosmetic, dermatopharmaceutical and pharmaceutical compositions is also well known as taught by Griat, abstract and col. 1, lines 8-17. Griat also teaches acidic pH values such as less than 3.5 for an improve stabilization at col. 1, lines 55-67.

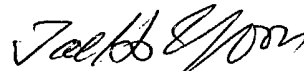
It would have been obvious to one skilled in the art at the time of invention to white mineral oil of Clark in Robinson et al since Robinson et al teach employing various liquid hydrocarbon such as mineral oil at col. 2, lines 54-62, or to utilize a pH of less than 5.5 in Robinson et al and to use the inverse latex of Robinson et al in making cosmetic, dermatopharmaceutical and pharmaceutical compositions taught by Griat since the use of the inverse latex in cosmetic, dermatopharmaceutical and pharmaceutical compositions and of the acidic pH are well known as taught by Griat absent showing otherwise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/April 22, 2004
